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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/884,051	06/20/2001	Yoshiki Kawaoka	3562-0117P	2692

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EXAMINER

VILLECCO, JOHN M

ART UNIT	PAPER NUMBER
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2612

DATE MAILED: 09/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary**Application No.**

09/884,051

Applicant(s)

KAWAOKA ET AL.

Examiner

John M. Villecco

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-55 is/are pending in the application.
- 4a) Of the above claim(s) 3,12-19,22 and 30-37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,10,11,20,21,23,28,29,38-42,44-50 and 52-55 is/are rejected.
- 7) ☒ Claim(s) 5-9,24-27,41,43,44 and 51 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments, see pages 19 and 20 of the amendment, filed on June 24th, 2005, with respect to applicants assertion that claims 1 and 20 are generic to all three of the different embodiments, have been fully considered and are persuasive. The examiner's statement that claims 1 and 20 are generic only to the first and third embodiments has been withdrawn. Additionally, applicant has added claims 39-55. Each of which read on the first embodiment that was elected by the applicant.
2. Additionally, applicant has amended each of the independent claims 1 and 20, thereby overcoming the rejection set forth in previous office action. Please see the new grounds of rejection presented on the following pages.

Claim Objections

3. Claims 41 and 44 is objected to because of the following informalities:
 - In, line 2 of claim 41, applicant recites the phrase "said digital camera configured to". This wording is unclear. It appears that applicant meant to use the phrase – said digital camera is configured to –.
 - In line 2 of claim 44, applicant recites the phrase "transmits communicates".
When taken in context with the rest of the claim, this phrase is hard to understand.
For examination purposes it will be assumed that the applicant meant to use the phrase – communicates –.

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Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 40-42 and 48-50 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

6. Regarding newly added claims 40 and 48, applicant has included the limitation of allowing the user the option to compress the photo images so that the cost of transmitting the compressed photo images is within a predetermined cost range when the cost for transmitting the photo images is above a predetermined cost range. However, the examiner can find no mention in the specification of allowing the user the option to compress the images. From an overview of the specification, a discussion of this limitation is found on page 24, lines 1-21. As the present invention is a camera for automatic image transmission, one of ordinary skill in the art would assume that this image compression step would be an automatic image compression rather than a compression based on user inputs, based on the specification. As such, since there is no mention of allowing the user an option to compress the image, the claimed subject matter is considered new matter.

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7. Regarding newly added claims 41, 42, 49, and 50, applicant has included the limitation of transmitting a subset of photo images so that the cost of transmitting the subset of photo images is within a predetermined cost range. However, in the discussion of this limitation found on page 24, line 25 to page 25, line 22 of the applicant's specification, applicant mentions transmitting images in order to reduce the amount of communication time in order to optimize transmission costs. Subsets of images are transferred according to whether or not units of communication would be unnecessarily wasted, not based on a whether the transmission of a subset of image fall with a predetermined cost range. There is not discussion of a predetermined cost range in the discussion of this limitation in the specification. As such, since there is no mention of transmitting a subset of image according to whether or not the cost of transmission is within a predetermined cost range, the claimed subject matter is considered new matter.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. **Claims 1, 10, 20, 28, 38, 46, 54, and 55 are rejected under 35 U.S.C. 102(e) as being anticipated by Fukushima et al. (U.S. Patent No. 6,253,023).**

10. Regarding *claim 1*, Fukushima discloses a camera capable of sending an image over a transmission network after checking on the transmission conditions. More specifically,

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Fukushima discloses a digital camera (2100) that includes an interface (2010), which is interpreted to be the transmission section, and a system controlling circuit (2024), which is interpreted to be the transmission control unit. The system controlling circuit (2024) operates to capture images and control the transfer of images out of the camera (2100). The camera operates to capture an image (S2005) and after the capture of the image is complete (col. 32, lines 5-6) determination is made whether or not to transmit an image. A number of transmission conditions are checked before the image transmission is carried out. For instance, the transmission means is detected, the number of transmission means is detected, and the optimal transmission means is detected. All of these conditions are interpreted to be the transmission allowance conditions. Inherently, the system controlling circuit (2024) operates to check if each of the transmission allowance conditions have been met. If each of the transmission allowance conditions have been evaluated, then the system operates to transmit the images.

11. As for **claim 10**, Fukushima discloses a transmission switch (2038) and means for selecting an image to be transferred (col. 32, lines 51-53). This information is sent to the system controlling circuit (2024) indicating that the image is to be transferred to the external device (2200).

12. **Claim 20** is considered a method claim corresponding to claim 1. Please see the discussion of claim 1 above.

13. **Claim 28** is considered a method claim corresponding to claim 10. Please see the discussion of claim 10 above.

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14. Regarding *claim 38*, Fukushima discloses that a plurality of factors are considered before image transfer, such as, transmission means, the number of transmission means, and the optimal transmission means. See Figures 16-18.

15. With regard to *claim 46*, Fukushima discloses that the method of transmission takes place in a camera (2100).

16. Regarding *claim 54*, as mentioned above, Fukushima discloses that a plurality of different transmission conditions are checked, including the transmission means, the number of transmission means, and the optimal transmission means. See Figures 16-18. When each of these conditions has been checked and satisfied, the image is transmitted to the external device (S2016).

17. *Claim 55* is considered a method claim corresponding to claim 54. Please see the discussion of claim 54 above.

Claim Rejections - 35 USC § 103

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

19. **Claims 2 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fukushima in view of Tamura et al. (U.S. Application Publ. No. 2004/0169730 A1).**

20. Regarding *claim 2*, as mentioned above in the discussion of claim 54, Fukushima discloses all of the limitations of the parent claim. However, Fukushima fails to explicitly

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disclose a battery, wherein the storage level of the battery is used a predetermined transmission allowance condition. Tamura, on the other hand, discloses camera that checks the battery level of the camera before transmitting images in order to determine if enough battery power is left for a successful transmission. More specifically, as shown in Figures 9 and 10 and discussed in paragraphs 0197-0201, Tamura discloses determining the number of sheets for transmission, then checking the battery to determine how many sheets can successfully be transmitted. If the number of sheets to be transmitted is more than the number of sheets that can successfully be transmitted using the battery, then transmission of the images does not occur. If the amount of battery is sufficient then the transmission of the images to the printer is allowed. Additionally, Tamura discloses that instead of calculating the number of sheets to be transmitted, the number of bytes to be transmitted can be used. This feature allows for the successful transmission of image data based on the battery power left. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to determine if the amount of battery left in Fukushima is sufficient for the successful transfer of images to the computer.

21. *Claim 21* is considered a method claim corresponding to claim 2. Please see the discussion of claim 2 above.

22. **Claims 4 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fukushima et al. (U.S. Patent No. 6,253,023) in view of Iizuka (Japanese Publ. No. 09-288684 A).**

23. Regarding *claim 4*, as mentioned above in the discussion of claim 54, Fukushima discloses all of the limitations of the parent claim. However, Fukushima fails to explicitly

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disclose transmitting data depending on a timer. Iizuka, on the other hand, discloses that it is well known in the art to transmit images based on a set schedule. More specifically, Iizuka discloses a method of posting updated images on a website. The system includes image gathering terminals (1a-1d) and an image collection terminal (3). When a timer indicates that it is time to collect images the image collection terminal calls the image gathering terminals and requests images. This feature allows for a continuously updated image stream viewable over a network. Therefore, it would have been obvious to incorporate a system within the camera of Fukushima that transmits images a specified times of the days so that an updated image is continuously presented over a network. An official translation of this reference has been ordered for use in subsequent office actions.

24. *Claim 23* is considered a method claim corresponding to claim 4. Please see the discussion of claim 4 above.

25. **Claims 11 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fukushima in view of Safai (U.S. Patent No. 6,715,003).**

26. Regarding *claim 11*, as mentioned above in the discussion of claim 54, Fukushima discloses all of the limitations of the parent claim. However, Fukushima fails to explicitly disclose an addressee registration section for registering a phone number of an addressee for transmitting the photo images. Safai, on the other hand, discloses that it is well known in the art to register the destination information of an image to be transmitted. More specifically, as disclosed in column 8, line 37 to column 9, line 20, a user is able to enter a destination email address or select a destination email address from a list. Additionally, Safai discloses that the

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address does not have to specifically be an email address. The address can also be a phone number (col. 10, line 54). This feature allows a user to select a destination address to associate with an image that is to be transmitted. Thus, a user can transmit an image to any user who they decide. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to allow a user to register a phone number of a destination user in the camera of Fukushima so that user has control over who the image data is to be transmitted.

27. *Claim 29* is considered a method claim corresponding to claim 11. Please see the discussion of claim 11 above.

28. **Claims 39 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fukushima et al. (U.S. Patent No. 6,253,023) in view of Iizuka (Japanese Publ. No. 09-288684 A) and further in view of Shibata et al. (Japanese Publ. No. 56152368 A).**

29. Regarding *claim 39*, as mentioned above in the discussion of claim 4, the combination of Fukushima and Iizuka discloses all of the limitations of the parent claim. However, neither of the aforementioned references discloses that the predetermined time range is based on a cost of transmission. Shibata, on the other hand, discloses that it is well known in the art to delay the transmission of image data until a specific time so that it will be cheaper to transmit the image. See the abstract. More specifically, Shibata teaches sending a facsimile at night when telephone charges are cheap, thus saving money on the image transmission. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to delay the image transmission of Fukushima so that the image is transmitted at a time when the image transmission will be cheapest (e.g. at night) so as to save money.

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30. *Claim 47* is considered a method claim corresponding to claim 11. Please see the discussion of claim 11 above.

31. **Claims 44, 45, 52, and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fukushima et al. (U.S. Patent No. 6,253,023).**

32. Regarding *claim 44*, as mentioned above in the discussion of claim 1, Fukushima discloses all of the limitations of the parent claim. However Fukushima fails to explicitly disclose that the transmission section communicates wirelessly to a wireless communication device. Official Notice is taken as to the fact that it is well known in the art to transmit images wirelessly. Transmitting images wirelessly provides for more mobility for the user and less bulky cameras, due to the reduction of cabling. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the camera of Fukushima communicate wirelessly in order to provide the user with more mobility and less cabling.

33. As for *claim 45*, as mentioned above in the discussion of claim 1, Fukushima discloses all of the limitations of the parent claim. However Fukushima fails to explicitly disclose that the wireless communication device is a cellular telephone. Official Notice is taken as to the fact that it is well known in the art to transmit image wirelessly from a camera to a cellular telephone. The ability to transfer an image from a camera to cellular telephone enables a user to send images to the wireless telephone for transfer over the cellular network. Thus, it would have been obvious to one of ordinary skill in the art to transfer images from a camera to cellular telephone so that the image can be transferred over the cellular network.

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34. Claim 52 is considered a method claim corresponding to claim 44. Please see the discussion of claim 44 above.

35. Claim 53 is considered a method claim corresponding to claim 44. Please see the discussion of claim 44 above.

Allowable Subject Matter

36. Claims 5-9, 24-27, 43, and 51 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

37. The following is a statement of reasons for the indication of allowable subject matter:

Regarding ***claims 5 and 24***, the primary reason for indication of allowable subject matter is that the prior art fails to teach or reasonably suggest that the transmission control unit notifies a user of a period of time to an end of the predetermined time range, based on the time obtained by the time obtaining section.

As for ***claims 6 and 25***, the primary reason for indication of allowable subject matter is that the prior art fails to teach or reasonably suggest that the predetermined transmission allowance condition includes a condition when a cost for transmitting the photo images calculated by the data amount-obtaining section is within a predetermined range.

With regard to ***claims 9 and 27***, the primary reason for indication of allowable subject matter is that the prior art fails to teach or reasonably suggest that the predetermined transmission allowance condition includes a condition when a remaining time for transmitting

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said photo images is shorter than a predetermined time, in a case where a cost for a transmission is calculated based on unit communication time.

Regarding *claims 43 and 51*, the primary reason for indication of allowable subject matter is that the prior art fails to teach or reasonably suggest that the at least one transmission allowance condition other than the completion of photography includes a time duration required for transmitting said photo images being at or above a predetermined time duration level.

38. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John M. Villecco whose telephone number is (571) 272-7319. The examiner can normally be reached on Monday-Friday.

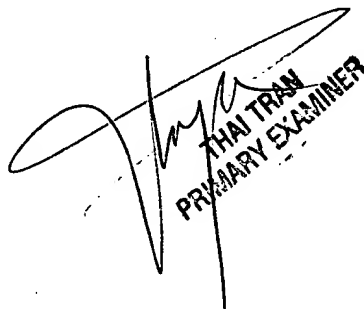
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wendy Garber can be reached on (571) 272-7308. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



John M. Villecco
September 14, 2005



THAI TRAN
PRIMARY EXAMINER